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Brian N. Tufte Crompton, Seager & Tufte Ste. 800 1221 Nicollet Avenue Minneapolis, MN 55403			NEGRON, ISMAEL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/811,670	TUFTE, BRIAN N.
	Examiner	Art Unit
	Ismael Negron	2885

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 February 2007.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-17 and 21-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 26-31 is/are allowed.

6) Claim(s) 1,3-17,21,23-25 and 32 is/are rejected.

7) Claim(s) 22 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/21/2007.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION***Response to Amendment***

1. Applicant's amendment filed on February 21, 2007 has been entered. Claims 1 and 3-17 have been amended. Claim 2 has been cancelled. Claims 21-32 have been added. Claims 1, 3-17 and 21-32 are still pending in this application, with claims 1, 12, 15, 21, 26 and 32 being independent.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 15-17** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,921,184 (TUFTE). Although the conflicting claims are not identical, they are not patentably distinct from each other.
3. TUFTE teaches an illumination device having:
 - **an elongated light source (as recited in Claim 15), column 27, lines 31 and 32;**
 - **an elongated member having a light receiving cavity or lumen extending lengthwise for receiving the elongated light source (as recited in Claim 15), column 27, lines 31-33;**
 - **the light receiving cavity or lumen being defined by a cavity or lumen wall (as recited in Claim 15), column 27, lines 33-35;**
 - **a slit or opening traversing along a length of the elongated member and extending from an outer surface of the elongated member and into the light receiving cavity or lumen to facilitated insertion and/or extraction of the elongated light source from the light receiving cavity or lumen (as recited in Claim 16), column 27, lines 46-51.**

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4. TUFTE teaches all the limitations of the claims, except:

- the light source having a round or substantially round cross section (as recited in Claim 15);
- the light receiving cavity or lumen having a round or substantially round cross section that spans at least 180 degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen (as recited in Claim 15); and
- the light receiving cavity or lumen having a maximum dimension of 10 mm or less (as recited in Claim 17).

5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a round or substantially round, in cross section, elongated light source and cavity (as recited in Claim 15), with such cavity having a maximum dimension of 10 mm or less (as recited in Claim 17), because it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of specific shape and/or relative dimensions of the claimed device, and a device having the claimed shape or relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See *In re Dailey*, 149 USPQ 47 (CCPA 1976); and *In Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (Fed. Cir. 1984). In this case, selecting a given shape and/or dimension would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a given application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by GAGNE (U.S. Pat. 5,499,170).**

7. GAGNE discloses an illumination device having:

- **a carrier (as recited in Claim 12),** Figure 2, reference number 50;
- **the carrier having a back support (as recited in Claim 12),** Figure 2, reference number 54;
- **the carrier having a first and a second leg (as recited in Claim 12),** Figure 2, reference numbers 51 and 52;
- **the first leg and the second leg extending from the back support to form a cavity (as recited in Claim 12),** column 3, lines 45-50;
- **the carrier having a light receiving cavity or lumen for receiving an elongated light source (as recited in Claim 12),** Figure 2, reference number 56;
- **an insert (as recited in Claim 12),** Figure 2, reference number 70;

- **the insert having a main body (as recited in Claim 12), Figure 2, reference number 74;**
- **the insert having a first and a second leg (as recited in Claim 12), Figure 2, reference numbers 71 and 72;**
- **the first leg and the second legs being adapted engage the first and second legs of the carrier when the insert is installed into a seat position with the carrier (as recited in Claim 12), column 4, lines 58-67;**
- **the sidewalls being configured to retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier (as recited in Claim 12), as evidenced by Figure 2;**
- **the light receiving cavity or lumen of the carrier being positioned behind the insert when the insert is installed in the seat position with the carrier (as recited in Claim 13), as seen in Figure 2;**
- **the insert including at least one region that is transparent or semi-transparent and adapted to allow at least some of the light emitted by a light source to escape to a viewing side of the device (as recited in Claim 14), Figure 2, reference number 74.**

8. **Claim 15** is rejected under 35 U.S.C. 102(b) as being anticipated by BURKITT, III et al. (U.S. Pat. 5,680,496).

9. BURKITT, III et al. discloses an illumination device having:

- **an elongated light source (as recited in Claim 15);**
- **the elongated light source having a round or substantially round cross section (as recited in Claim 15), as evidenced by Figure 1 and 2;**
- **an elongated bumper member (as recited in Claim 15), Figure 2, reference number 14;**
- **the elongated bumper member having a light receiving cavity of lumen (as recited in Claim 15), Figure 2, reference number 28;**
- **the light receiving cavity or lumen being defined by cavity or lumen wall (as recited in Claim 15), as seen in Figure 2;**
- **the cavity or lumen wall having a round or substantially round shape that spans at least 180 degrees (as recited in Claim 15), as seen in Figure 2; and**
- **the cavity or lumen wall being sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall (as recited in Claim 15), as evidenced by Figure 1 and 2.**

10. **Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by BURKITT, III et al. (U.S. Pat. 5,680,496).**
11. BURKITT, III et al. discloses an illumination device having:

- **elongated light source means for emitting light rays, Figure 1, reference number 12;**
- **an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a protected surface during normal use of such protected surface, Figure 1, reference number 10;**
- **the elongated bumper means including means for allowing light rays from the elongated light source means to be emitted along at least a majority of the length of the elongated bumper means, Figure 1, reference number 14;**
- **the elongated bumper means further having a primary bumper surface that faces away from the protected surface, Figure 1, reference number 30;**
- **the elongated light source means being situated between the primary bumper surface and the protected surface, as evidenced by Figure 2;**
- **the primary bumper surface helping to shield and protect the elongated light source means during normal use of the protected surface, as evidenced by Figure 2.**

12. Regarding the protected surface being a boat, the applicant is advised that, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429. In addition, it has been held by the courts that apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990). In this case, the patented apparatus of BURKITT, III et al. discloses (as detailed above) all the structural limitations required to perform the recited functional language, therefore was considered to anticipate the claimed illumination device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).**

14. BURKITT, III et al. discloses an illumination device having:

a carrier (as recited in Claim 1), Figure 2, reference number 16;

- **the carrier having a back support (as recited in Claim 1), Figure 2, reference number 24;**
- **the carrier having a first leg and a spaced second leg (as recited in Claim 1), Figure 2, reference number 40;**
- **the first leg and the second leg extending from the back support to define a carrier cavity (as recited in Claim 1), column 3, lines 58-60;**
- **the first and second leg including terminating ends opposite the back support (as recited in Claim 1), as seen in Figure 2;**
- **the terminating ends defining a gap that is part of the carrier cavity (as recited in Claim 1), as seen in Figure 2;**
- **an insert (as recited in Claim 1), Figure 2, reference number 14;**
- **the insert having a main body (as recited in Claim 1), Figure 2, reference number 30;**
- **the insert having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 34;**
- **the first and second legs being adapted to provide an interference fit with the first leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the main body of the insert having a light receiving cavity or lumen (as recited in Claim 1), Figure 2, reference number 28;**

- **the light receiving cavity or lumen extending lengthwise defined by sidewalls for receiving an elongated light source (as recited in Claim 1), column 3, lines 44 and 45;**
- **the carrier including one or more insert stops (as recited in Claim 5), Figure 2, reference number 38;**
- **the insert stops extending from the back support of the carrier into the carrier cavity (as recited in claims 5 and 6), as seen in Figure 2;**
- **the carrier including a first insert stop and a second insert stop (as recited in Claim 6), Figure 2, reference number 38;**
- **the first and the second insert stops each including an angled surface (as recited in Claim 6), as seen in Figure 2;**
- **at least part of the insert being adapted to engage the angled surface of the first insert stop and the angle surface of the second insert stop if a sufficiently large force is exerted on the insert toward the carrier (as recited in Claim 7), as evidenced by Figure 2;**
- **the main body of the insert including a transparent or semi-transparent material (as recited in Claim 8), column 3, lines 52-54; and**
- **the transparent or semi-transparent material extending from the light receiving cavity or lumen to an outside surface of the**

main body on a viewing side of the device when the insert is installed in the seat position (as recited in Claim 8), as seen in Figure 2.

15. BURKITT, III et al. discloses all the limitations of the claims, except:

- a slit (as recited in Claim 1);
- the slit extending from an outer surface of the insert into the lumen (as assumed from Claim 1);
- the interference fit of the first and second legs of the insert with the first and second legs of the carrier providing a force that urges the slit towards a closed position (as recited in Claim 3); and
- the main body including a non-transparent material (as recited in Claim 9).

16. BELL (U.S. Pat. 5,410,458) discloses illumination device having:

- **an elongated member (as recited in Claim 1)**, Figure 4, reference number 104
- **the elongated member having a lumen (as recited in as recited in Claim 1)**, as seen in Figure 4;
- **the cavity being for receiving the light source (as recited in Claim 1)**, column 3, lines 30-33;
- **a slit (as recited in Claim 2)**, Figure 4, reference number 110;

the slit extending from an outer surface of the insert into the lumen (as assumed from Claim 2), as seen in Figure 4; and the elongated member including a non-transparent material (as recited in Claim 9), column 3, lines 64-68.

17. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. (as recited in Claim 1), to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55). It would have further being obvious to place such slit on the side facing the elongated carrier for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member, such arrangement inherently forcing the carrier to provide closing force to the slit (as recited in Claim 3).

18. Regarding at least a majority of the elongated light source being situated inside the carrier cavity when the insert is installed in the seat position (as recited in Claim 4), the applicant is advised that, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429.

1429. In addition, it has been held by the courts that apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990). In this case, the independent Claim 1 failed to

positively define the elongated light source as part of the claimed invention structure (see "for receiving an elongated light source" in line 11), while Claim 4 merely requires a majority of such elongated light source as being positioned inside the carrier cavity. The patented structure of BURKITT, III et al. was considered capable of receiving at least a majority of an elongated light source inside the carrier cavity when the insert is installed in the seat position, as claimed. However, even if the elongated light source was positively claimed as part of the instant invention, arranging the patented structure of BURKITT, III et al. to receive at least a majority of the elongated light source inside the carrier cavity would have been obvious to one of ordinary skill in the art at the time the invention was made, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In this case, positioning the elongated light source of BURKITT, III et al. so that at least a majority of such elongated light source is inside the carrier cavity when the insert is installed in the seat position (as recited in Claim 4) would not change the operation or functionally to the patented device.

19. Regarding the main body including a non-transparent material (as recited in Claim 9), it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the non-transparent material of the elongated member of BELL in the insert of the patented device of BURKITT, III et al. to provide a desired illumination effect, as per the teachings of BELL.

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20. **Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).**

21. BURKITT, III et al. discloses, or suggests, all the limitations of the claims (as detailed in previous sections 13-17), except the maximum dimension of the light receiving cavity or lumen being less than 20 mm (as recited in Claim 10) or 10 mm (as recited in Claim 11).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the light receiving cavity or lumen of the insert of BURKITT, III et al. to have a maximum dimension of less than 20 mm (as recited in Claim 10) or 10 mm (as recited in Claim 11), since it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, selecting a given dimension would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a given application.

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23. **Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).**

24. BURKITT, III et al. discloses all the limitations of the claims (as detailed in previous section 9), except:

- a slit or opening (as recited in Claim 16);
- the slit or opening traversing along a length of the elongated bumper member (as recited in Claim 16);
- the slit or opening extending from an outer surface of the elongated bumper member and into the light receiving cavity or lumen to facilitate insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen (as recited in Claim 16);
- the maximum dimension of the light receiving cavity or lumen being less than 10 mm (as recited in Claim 17).

25. BELL discloses illumination device having:

- **an elongated member (as recited in Claim 15), Figure 4, reference number 104**
- **the elongated member having a light receiving cavity or lumen (as recited in as recited in Claim 15), as seen in Figure 4;**
- **the light receiving cavity or lumen being for receiving a light source (as recited in Claim 15), column 3, lines 30-33;**

- **a slit or opening (as recited in Claim 16), Figure 4, reference number 110;**

- **the slit or opening traversing along a length of the elongated bumper member (as recited in Claim 16), column 3, lines 6-9;**

- **the slit or opening extending from an outer surface of the elongated bumper member and into the light receiving cavity or lumen to facilitate insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen (as assumed from Claim 16), as seen in Figure 4.**

26. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. (as recited in Claim 16), to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55).

27. Regarding the maximum dimension of the light receiving cavity or lumen, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the insert of BURKITT, III et al. to have a light receiving cavity or lumen maximum dimension of less than 10 mm (as recited in Claim 17), since it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed

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device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, selecting a given dimension would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a given application.

28. **Claims 21 and 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

29. BURKITT, III et al. discloses an illumination device having:

- **a carrier (as recited in Claim 21)**, Figure 2, reference number 16;
- **the carrier having a back support (as recited in Claim 21)**,
Figure 2, reference number 24;
- **the carrier having a first leg and a spaced second leg (as recited in Claim 21)**, Figure 2, reference number 40;
- **the first leg and the second leg extending out from the back support to form a carrier cavity (as recited in Claim 21)**, column 3, lines 58-60;
- **an insert (as recited in Claim 21)**, Figure 2, reference number 14;
- **the insert having a main body (as recited in Claim 21)**, Figure 2, reference number 30;
- **the insert having a first leg and a second leg (as recited in Claim 21)**, Figure 2, reference number 34;

- **the first and second legs being adapted to provide an interference fit with the first and second legs of the carrier, respectively, when the insert is installed in a seat position with the carrier (as recited in Claim 21), column 3, lines 60-64;**
- **the insert having a light receiving cavity or lumen extending lengthwise for receiving an elongated light source (as recited in Claim 21), Figure 2, reference number 28;**
- **the insert having an at least partially transparent material that extends from the light receiving cavity or lumen to an outer surface of the insert on a viewing side of the rub-rail assembly (as recited in Claim 21), column 3, lines 52-54;**
- **the insert being configured such that light is only allowed to escape from the elongated light source on the viewing side of the rub-rail assembly along an arc with a center in the light receiving cavity or lumen that spans less than 180 degrees (as recited in Claim 23), as evidenced by Figure 2;**
- **the elongated light source having a size and shape (as recited in Claim 24), as evidenced by Figures 1 and 2;**
- **the light receiving cavity or lumen being defined by a cavity or lumen wall (as recited in Claim 24), Figure 2, reference number 28; and**

- **the light receiving cavity or lumen having, in cross-section, a shape and size to accommodate the size and shape of the elongated light source, so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall (as recited in Claim 24), as evidenced by Figure 2.**

30. BURKITT, III et al. discloses all the limitations of the claims, except:

- the insert further having a substantially non-transparent material also on the viewing side of the rub-rail assembly (as recited in Claim 21);
- a slit or opening extending into the light receiving cavity or lumen (as recited in Claim 25);
- the slit or opening being for facilitating insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen (as recited in Claim 25).

31. BELL (U.S. Pat. 5,410,458) discloses illumination device having:

- **an elongated member (as recited in Claim 21), Figure 4, reference number 104**
- **the elongated member having a lumen (as recited in as recited in Claim 21), as seen in Figure 4;**

- **the cavity being for receiving an elongated light source (as recited in Claim 21), column 3, lines 30-33;**
- **the insert having an at least partially transparent material that extends from the light receiving cavity or lumen to an outer surface of the insert on a viewing side of the rub-rail assembly (as recited in Claim 21), column 2, lines 66 and 67;**
- **the insert further having a substantially non-transparent material also on the viewing side of the rub-rail assembly (as recited in Claim 21), column 3, lines 64-68;**
- **a slit or opening (as recited in Claim 25), Figure 4, reference number 110;**
- **the slit or opening extending into the light receiving cavity or lumen (as recited in Claim 25), as seen in Figure 4; and**
- **the slit or opening being for facilitating insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen (as recited in Claim 25), column 3, lines 51-55.**

32. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the non-transparent material of the elongated member of BELL in the insert of the patented device of BURKITT, III et al. to provide a desired illumination effect, as per the teachings of BELL.

33. Regarding the slit, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. (as recited in Claim 1), to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55). It would have further been obvious to place such slit on the side facing the elongated carrier for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member, such arrangement inherently forcing the carrier to provide closing force to the slit (as recited in Claim 3).

Allowable Subject Matter

34. Claims 26-31 are allowed.

35. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

36. The following is an examiner's statement of reasons for allowance:

Applicant teaches a rub-rail assembly having a carrier, an insert, and a light-receiving cavity. The insert include first and second legs for providing an interference fit with the interior surface of the carrier, while a main body of the insert engages at least

part of the outside surface of the carrier, when the insert is installed in a seat position with the carrier. In a second embodiment, the first and second legs of the insert are formed from a substantially non-transparent material.

No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the insert first and second legs providing an interference fit with the interior surface of the carrier while a main body of the insert engages at least part of the outside surface, or the first and second legs of the insert being formed from a substantially non-transparent material, in combination with the other structural limitations of the claimed rub-rail assembly.

37. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

38. Applicant's arguments filed February 21, 2007 have been fully considered but they are not persuasive.

39. Regarding the Examiner's rejection of Claim 1 (subject matter previously presented in Claim 2) under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III

et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the insert including a slit to facilitate insertion of the light source into the light receiving cavity or lumen. The applicant further argues that BELL teaches away from the proposed modification, as the cited reference suggests, according to the applicant, positioning the slit so that the light source could be removed from the insert without having to remove the insert from the carrier. The applicant further argues that there is nothing in either of the cited references that would suggest that placing the slit in the back of the insert would in any way prevent the light source from being accidentally removed from the insert.

40. In response to applicant's arguments that BURKITT, III et al. and BELL failed to disclose individually, or even suggest when combined, a slit included in the insert to facilitate insertion of the light source into the light receiving cavity or lumen, the applicant is respectfully directed to previous sections 14-17, where such limitations are addressed.

41. Regarding applicant's arguments that BELL teaches away from the proposed modification, it is noted that the applicant is using "teaching away" in a much broader sense that it is legally accepted. For a reference to be considered to teach away from a proposed modification such reference must criticize, discredit, or otherwise discourage the proposed combination. *In re Fulton*, 73 USPQ2d 1141 (Fed. Cir. 2004). The applicant is further advised that disclosed examples and/or preferred embodiments do

not constitute a teaching away from a broader disclosure or nonpreferred embodiments, even if such nonpreferred embodiments are described as somewhat inferior. See *In re Susi*, 169 USPQ 423 (CCPA 1971), and *In re Gurley*, 31 USPQ2d 1130 (Fed. Cir. 1994). In this case, BELL discloses a transparent member 104 including an interior cavity for receiving a light string 116, and a slit 110 extending from the outer surface of the member 104 to the interior cavity, such slit 110 being provided specifically for removing the light source 116 from the interior cavity. It is noted that slit 110 is only disclosed by BELL to be located at the lowest possible point of the transparent member 104. Not only does BELL fails to teach away from the claimed slit, but, as previously detailed, it would have been obvious to one of ordinary skill in the art to provide such slit to the elongated member of BURKITT, III et al., to enable the light source of BURKITT, III et al. to be easily removed for service or replacement, as explicitly suggested by BELL (see column 3, lines 51-55).

42. Regarding applicant's arguments that there is nothing in either of the cited references that would suggest placing the slit on the side facing the elongated carrier, the applicant is advised that suggestion or motivation to modify a prior art structure can be found in a reference, or reasoned from common knowledge in the art, scientific principles, art recognized equivalents, or legal precedent. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as previously detailed, one of ordinary skill in the art at the time of invention would have been motivated to formed the slit of BELL on the side facing of the insert of BURKITT, III et al. facing the elongated carrier for

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presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member.

43. Regarding the Examiner's rejection of claims 3-11, the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 1, and would be allowable when/if the independent claim is allowed.

44. Regarding the Examiner's rejection of Claim 12 under 35 U.S.C. 102(b) as being anticipated by GAGNE (U.S. Pat. 5,499,170), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the sidewalls of the light receiving cavity or lumen being configured to retain the elongated light source in place even when the insert is separate from the carrier. The applicant further states that the elongated light source of GAGNE is retained in place by way of a double-sided tape 51 (actually, reference number 99 in Figures 1 and 2).

45. In response to applicant's arguments that GAGNE failed to disclose the sidewalls of the light receiving cavity or lumen being configured to retain the elongated light source in place even when the insert is separate from the carrier, the applicant is once again advised that it has been held that the recitation that an element is "configured to" performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In this case, as admitted by the applicant, the sidewalls of the light receiving

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cavity or lumen are indeed capable of retaining the elongated light source of GAGNE (e.g. by means of adhesive tape 99), even when the insert is separated from the carrier.

46. Regarding the Examiner's rejection of claims 13 and 14, the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 12, and would be allowable when/if the independent claim is allowed.

47. Regarding the Examiner's rejection of Claim 15 under 35 U.S.C. 102(b) as being anticipated by BURKITT, III et al. (U.S. Pat. 5,680,496), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the light receiving cavity or lumen wall being sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen, as defined by the light receiving cavity or lumen wall. The applicant further argues that light source of BURKITT, III et al. appears to occupy only about 55% of the light receiving cavity or lumen.

48. In response to applicant's arguments that BURKITT, III et al. failed to disclose the elongated light source filling or substantially filling the light receiving cavity or lumen, the applicant is respectfully directed to Figure 1 of the cited reference where the elongated light source 12 is clearly shown filling or substantially filling the light receiving cavity or lumen 28. It appears that the applicant mistakenly took BURKITT, III et al.

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exemplary showing of **some** of the optical fibers forming the **whole** of the elongated light source 12, as showing the true shape of such elongated light source.

49. Regarding the Examiner's rejection of Claim 16 under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the insert including a slit to facilitate insertion of the light source into the light receiving cavity or lumen.

50. In response to applicant's argument regarding Claim 16, the applicant is respectfully directed to previous sections 39-42, where such arguments are addressed as they apply to Claim 1.

51. Regarding the Examiner's rejection of Claim 17 under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the light receiving cavity or lumen having a maximum dimension of 10 mm or less.

52. In response to applicant's argument regarding Claim 17, the applicant is respectfully directed to previous section 27, where the argued limitation is addressed.

53. Regarding applicant's argument with respect to newly presented claims 21-32, the applicant is respectfully directed to previous sections 10-12 and 28-35, where such claims are addressed.

Conclusion

54. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

55. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee, can be reached on (571) 272-7044. The facsimile machine number for the Art Group is (571) 273-8300.

57. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



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